REMARKS

In response to the Office Action mailed September 17, 2003, Applicant respectfully requests the reconsideration of the application in view of the remarks set forth below. As discussed above, no amendments to the claims have been made. Claims 19-36 are pending in this application.

Discussion of Formal Drawings

The Examiner requested that Applicant provide the formal drawings in reply to this Office Action. In reply, Applicant submits herewith a set of formal drawings. In Figure 2, Applicant has included an element name ("communication network") for reference numeral 4.

Discussion of Priority Under 35 U.S.C. § 119(a)-(d)

Applicant has noticed that the Office Action does not acknowledge a foreign priority claim under 35 U.S.C. § 119(a)-(d). However, Applicant made a claim to foreign priority in the declaration filed August 2, 2002. Applicant also notes that the filing receipt mailed October 18, 2002, confirms the foreign priority claim. Applicant will shortly file a certified copy of the priority document. Thus, Applicant respectfully requests that the next Office Action acknowledge the foreign priority claim.

Discussion of Claim Rejections Under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 19-36 under 35 U.S.C. § 103(a) as being unpatentable over Dieterman (U.S. Patent No. 6,393,464) in view of Scheussler, *et al* (U.S. Patent No. 6,366,950). However, all of the rejected claims are patentable over the prior art references as discussed below.

Dieterman is not in fact prior art

Applicant respectfully submits that Dieterman, the primary reference, is not in fact prior art. This application claims priority from Australian application PQ 0302/99, which was filed on May 12, 1999. However, the filing date of the Dieterman patent is June 10, 1999. That is, the effective filing date (May 12, 1999) of this application is prior to the effective date (June 10,

1999) of the Dieterman reference. Therefore, the Dieterman reference does not qualify as prior art under 35 U.S.C § 102(e).

None of the Remaining References Teach or Suggest the Claimed Invention

Independent Claim 19 recites, among other limitations, "determining if a message is approved for a recipient of the message," "processing the message for subsequent viewing by the recipient if the message is approved" and "notifying the recipient and storing the message if the message is unapproved." Independent Claims 29, 30 and 36 comprise similar limitations. However, as discussed below, none of the remaining references of record teach or suggest the claimed invention.

1. U.S. Patent No. 6,366,950 (Scheussler et al.)

Scheussler is directed to a system and method for identifying users in a distributed network (column 1, lines 9-10). The Scheussler reference does not teach or suggest the above claim limitations.

Referring to Figure 2, the Scheussler reference discloses a network of computers (20, 22), each computer (20, 22) having an identification module (33, 35) for generating an identification number that is unique to that computer. A client module (28, 30) in each computer generates messages including the identification number and sends those messages over the network. On receiving a message, the recipient computer retrieves the identification number from that message and determines whether it matches any of the identification numbers stored in the identification database. If a match is found, the message is accepted. Otherwise, the message may be blocked or rejected, as defined by the user.

The identification database (32) may be located on the recipient's computer or on a server (26) accessible over the network. The identification database (32) may include another database that stores information of active users (i.e. those users who are currently online). Scheussler at best discloses that "the email will be rejected" (column 7, line 5). This does not teach the notification feature of the claimed invention. Furthermore, Scheussler does not teach or suggest the remaining claim limitations of "determining if a message is approved for a recipient of the message" and "processing the message for subsequent viewing by the recipient if the message is approved."

2. U.S. Patent No. 6,199,102 (Cobb)

Cobb is directed to a system and method for filtering unsolicited electronic commercial messages (column 1, lines 7-8). Referring to Figure 7, messages received from a sender whose address appears in or matches a pattern in the Blocking List are filtered and blocked from reaching the recipient (e.g. stored in the deleted message folder) (415, 420). Messages received from a sender whose address is not caught by the Blocking List, but appears in or matches a pattern in the Acceptance List, are forwarded to the recipient (425, 430). Messages received from an unrecognized sender, whose address is not caught by either the Blocking or Acceptance Lists, will be sent a challenge to that sender's address (435). The challenge includes a prompt (e.g. a predetermined text question) and a blank answer area for the sender to place their response to the prompt.

The response is sent back to the recipient, which is then checked for validity (440). If the response is correct, the original message is forwarded to the recipient. Otherwise, the message is blocked and discarded (e.g. stored in the deleted message folder). However, the Cobb reference neither teaches nor suggests at least the indicated limitations recited in independent Claims 19, 29-30 and 36.

3. U.S. Patent No. 6,460,050 (Pace et al.)

Pace is directed to a content classification system which identifies content in an efficient, up-to-date manner (column 2, lines 6-8). Pace discloses a two-tiered file content classification system by deriving digital identifiers from each message received and characterizing those messages based on their identifiers (Figure 2). The first tier includes a message pre-processing module (110) which works with an email server to generate one or more digital identifiers, being a hash of at least a portion of the received email. The digital identifiers are generated according to the rules in a configuration file. The digital identifiers are forwarded to a second tier, which includes a database and processor (Figure 3).

The second tier increments the count of each digital identifier received per unit time stored in the database. Based on this frequency data and other information, a reply is generated from the given identifiers to indicate whether or not the message is spam. The reply is forwarded to the first tier, which determines how to process the email based on predetermined rules (e.g. forward the email directly to the email client or to a rejected message repository). However, the

Pace reference neither teaches nor suggests at least the indicated limitations recited in independent Claims 19, 29-30 and 36.

4. U.S. Patent No. 6,496,855 (Hunt et al.)

Hunt is directed to a registration processing system (11) for managing the registration of users with one or more websites (31, 32) by completing and transmitting a registration application on behalf of a user from a registration agent server node to the servers running the websites (Figures 1 and 2). During registration, the registration processing system (11) provides a unique proxy email address for each website a user seeks registration. The user's real email address is not provided during registration on each website.

Email sent to the proxy address is not stored but merely forwarded by the registration processing system (11) to the user's real email account. Thus users can selectively cut "spammers" off without having to change their real email address. Emails may be forwarded to the user based on an email filtering policy accepted by the user. However, the Hunt reference neither teaches nor suggests at least the indicated limitations recited in independent Claims 19, 29-30 and 36.

5. U.S. Patent No. 6,230,188 (Marcus)

Marcus is directed to a directory service system including a database for storing actual email addresses and a processing system for retrieving these listings from the database. The system responds to a user's request for a person's email address with a proxy email address instead of the actual email address. On selecting a proxy email address, the system may provide various fields for the user to construct an email (e.g. a subject description and message for the receiving party). The system uses this information to construct an email message which is sent to the listing recipient. However, the Marcus reference neither teaches nor suggests at least the indicated limitations recited in independent Claims 19, 29-30 and 36.

6. U.S. Patent No. 6,052,709 (Paul)

Paul is directed to a method and system for controlling the delivery of unsolicited email messages (column 1, lines 6-9). Referring to Figure 8, multiple spam probe email addresses are created and planted at various sites on a communications network to ensure their inclusion on

large-scale electronic junk mail mailing lists (801, 802). Messages received by each probe email address are monitored by a spam control center, which automatically analyzes the received spam email to identify the source of the message, extracts the spam source data from the message, and generates an alert signal containing the spam source data (803). The alert signal is broadcasted to network servers and/or user terminals within the communications network (804).

A filtering system implemented at the servers and/or user terminals receives the alert signal, updates an exclusion list containing filtering data derived from the spam source data in the alert signal, and controls the delivery of subsequent emails received from spam sources identified in the exclusion list (805, 806). The filter may run through incoming emails and/or records of outgoing emails stored in the database. The filter may also mark up incoming emails that match data stored in the exclusion list with a display code, or alternatively, alter one or more existing fields of the email to indicate the display status of the email. For example, emails marked with a "Junk" display code are not displayed in the user's inbox and are automatically discarded by the filter, or those emails may be displayed in the user's inbox in a distinctive color. However, the Paul reference neither teaches nor suggests at least the indicated limitations recited in independent Claims 19, 29-30 and 36.

7. U.S. Patent No. 6,480,885 (Olivier)

Olivier discloses a method for users to exchange group electronic mail by establishing individual profiles and criteria for determining personalized subsets within a group. Referring to Figure 5A, a user visits the registration website and subscribes to a mailing list (442, 445), specifying user profile data and acceptance criteria data that controls with whom and about what topics they wish to interact. The system stores this and other subscription information in the database (456). One or more servers calculate the degree of matches between the user and every other user, by doing a one-way or two-way match between users, using their profile data and acceptance criteria data (448). The results of these match calculations are stored in a database table as an individualized recipient list (452). When a user then sends a message to the mailing list, an email server retrieves all recipients in the recipient list and optionally filters down the recipient list to a message distribution list using each recipient's message acceptance criteria. The message is then distributed to matching users.

During message processing, as shown in FIG. 10, moderators within the recipient distribution list are located and one or more of them is emailed a request to approve the message for distribution. The message is stored in a suspended messages table in the database along with its distribution list until an approval or rejection is returned. If the message isn't approved or rejected after 5 days or another period of time, it is removed from the database and returned to the sender. If a moderator approves the message, it is then sent to the distribution list (column 15, lines 3-15).

Olivier teaches an approval of the message but the approval is for the distribution of the message. Thus, if the message is approved, the message is sent to the distribution list. Furthermore, if the message is rejected, the sender is informed via email. In contrast, in the claimed invention, the approval is *for a recipient of the message* and if the message is approved, *the message is processed for subsequent viewing by the recipient.* In addition, in the claimed invention, if the message in unapproved, *the recipient is notified.* Thus, the Olivier reference neither teaches nor suggests at least the indicated limitations recited in independent Claims 19, 29-30 and 36.

8. U.S. Patent No. 6,321,267 (Donaldson)

Donaldson discloses an active filter proxy (1401) that probes the sending host at the time it connects and implements a series of tests to determine if the remote host (1400) is likely to be either a dialup customer, or an open relay (Figure 13, 14). It also queries the mail server (1105) handling email for the supposed sender of the message to determine if the mail server (1105) will accept email for that address (i.e. whether r it is a valid email address) (Figure 12).

A sender's message must successfully pass through all the tests, or it is rejected and logged. Subsequent filters feed IP addresses back to the IP filtering mechanism, so subsequent mail from the same host can be easily blocked. Rejected emails are not stored on the active filter proxy (1401) or on the local mail server (1105) or user mail clients. Instead, the rejected message remains on the remote host (1400). However, the Donaldson reference neither teaches nor suggests at least the indicated limitations recited in independent Claims 19, 29-30 and 36.

Summary

As discussed above, the Dieterman reference is not in fact prior art. In addition, none of the remaining references teach or suggest the above-noted claim limitations recited in independent Claims 19, 29-30 and 36. Therefore, independent Claims 19, 29-30 and 36 are allowable over the prior art of record. Dependent Claims 20-28 and 31-35 depend from base Claim 19 or 30, and further define additional technical features of the present invention. In view of the patentability of their base claims, and in further view of their additional technical features, the dependent claims are patentable over the prior art of record.

CONCLUSION

In view of the Applicant's foregoing remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 12/16/03

By: _____

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